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Actor or Schmuck: Who Owns an Actor's Performance?

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I. Introduction

Is there any difference between Jack Nicholson and Heath Ledger's performances as the joker? These actors played batman's biggest foe, The Joker, in two different movies, with two very different interpretations of the role. If we could ask these actors today who created and controlled the right over the performances, it is doubtful that either would say anyone other than themselves. However, the way that copyright law is currently written in the United States, the writer or director has ownership rights over these performances.

An individual is protected under United States copyright law, if their piece is considered an "original work," they have authorship over the work, and the work is fixated in a "tangible medium of expression."¹ At first glance, it would seem apparent that an actor's performance would satisfy each of these benchmarks. However, recent cases heard by the Seventh and Ninth Circuits created a potential split when trying to answer this question.²

In this paper, the following section will discuss the background of this issue within federal copyright law. This section will lay out the history of the problem and the law itself, what the current state of the problem and law is, and how it affects the federal circuit courts today. Next, in Part III, the paper discusses the circuit split that recently arose in the Seventh and Ninth Circuit. Part IV will then analyze a possible solution to the issue, along with the ramifications of that solution and how difficult it will be to implement it. The paper argues that although an issue is apparent within this area of

¹ 17 U.S.C. §102.

² See, *Conrad v. AM Cmty. Credit Union*, 750 F.3d 634 (7th Cir. 2014); see, also *Garcia v. Google, Inc.*, 743 F.3d 929 (9th Cir. 2014).

federal law, it is fixable, but may come with some backlash from certain groups of people.

II. Background

a. The History

Copyright Law of the United States “is intended definitely to grant valuable, enforceable rights [. . .] without burdensome requirements; ‘to afford greater encouragement to the production of literary (or artistic) works of lasting benefit to the world.’”³ The first statute that provided a copyright regulated by courts was the Copyright Act of 1709, also called the Statute of Anne, which was passed by the Parliament of Great Britain in 1710.⁴ Copyright law in the United States was not enforced until 1790 because the American colonies were largely agrarian at the time and the Articles of Confederation did not empower the Continental Congress to issue copyrights.⁵

Article I Section 8 Clause 8 of the United States Constitution, called the Copyright Clause, states that Congress shall have the power “[t]o promote the Progress of Science and useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁶ Congress first exercised its copyright power with the Copyright Act of 1790, which is almost an exact copy of the Statute of Anne.⁷ The Copyright Act of 1790 only protected certain books, maps, and

³ *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

⁴ 3 Patry on Copyright § 8:10.

⁵ Yu, Peter K. Intellectual Property and Information Wealth: Copyright and Related Rights 142 (Greenwood Publishing Group, 2007).

⁶ U.S.C.A. Const. Art. I, § 8, Cl 8.

⁷ *Supra* note 5 at p 143.

charts.⁸ The Copyright Act was amended numerous times over its history, but most notably in 1831, 1870, 1909, and 1976. Amendments to the Copyright Act were made to extend the duration of the copyright, to add protection for newly discovered types of art and previously not considered works, to create agencies to oversee copyright registration and educate the public, and to keep up with global innovations in technology.⁹ An amended version of the Copyright Act of 1976 remains the primary copyright law in the United States today.¹⁰

Today, copyright law in the United States protects a wide array of works including literary, musical, dramatic, choreographic, pictorial, graphic, sculptural, audiovisual, and architectural works.¹¹ Copyright protection, however, does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”¹² The owner of a copyright according to United States copyright law has the exclusive rights to “reproduce the copyrighted work,” “prepare derivative works based upon the copyrighted work,” sell, rent, lease, or lend copies of the work, “perform the copyrighted work publicly,” “display the copyrighted work publicly,” and “perform the copyrighted work publicly by means of a audio transmission.”¹³ Those artists who are not protected by United States copyright law, do not normally have an automatic legal right of protection to any of those actions over their work.¹⁴ Artists may try to obtain a license for their work or possibly find protection in another form of

⁸ Patry, William F., “Introduction: The First Copyright Act. (Copyright Law and Practice 1994).

⁹ A BRIEF INTRODUCTION AND HISTORY, <http://copyright.gov/circs/circ1a.html>, (last visited Nov. 1, 2015).

¹⁰ 17 U.S.C.

¹¹ 17 U.S.C. §102.

¹² *Id.*

¹³ 17 U.S.C. §106.

¹⁴ *Id.*

applicable intellectual property law like trademark or patent, but this is unlikely to be successful as actors rarely have ownership interest in their performance.¹⁵

A protected interest under the Copyright Act must be an “original work of authorship fixed in any tangible medium of expression.”¹⁶ As it is written today, the Copyright Act does not explicitly protect actors or their performances.¹⁷ When reading 17 U.S.C. §101-07, one would think an actor’s performance meets all of these qualifications. However most federal claims for protection by actors in joint works such as films have resulted in different interpretations.¹⁸

It is also important to point out that one of the amendments enacted by Congress in copyright law, was in the creation of the United States Copyright Office to maintain and oversee copyright registration in the United States.¹⁹ The United States Copyright Office’s main functions include administering the copyright law, providing information to the public on copyright law, and protecting copyrights.²⁰ Information is provided to the public often through Circulars, which are published documents on the law.²¹ Circulars, which do not have the force of a statute, are considered by most courts to be “a fair summary of the law.”²²

In regards to registration, copyrights in general do not need to be registered.²³ According to Copyright Circular 1 “Copyright Basics”, copyright automatically exists

¹⁵ Litwak, Mark, “Do Your Actors Own Your Film”, Entertainment Law Resources, (Mar. 1, 2014), <http://www.marklitwak.com/blog/do-your-actors-own-your-film>.

¹⁶ 17 U.S.C. §102.

¹⁷ *Id.*

¹⁸ *See Garcia*, 786 F.3d 733; *see also, Conrad*, 750 F.3d 634.

¹⁹ 17 U.S.C. Ch. 7

²⁰ *Id.*

²¹ Circular 1, “Copyright Basics.”

²² *Mortg. Mkt. Guide, LLC v. Freedman Report, LLC*, 2008 U.S. Dist. LEXIS 56871 (D.N.J. July 28, 2008)

²³ Circular 1, “Copyright Basics.”

from the moment the work is created.²⁴ Works fall within copyright protection at the moment it is “created and fixed in a tangible form that is perceptible either directly or with the aid of a machine or device.”²⁵ However it is often smart to register, and its highly recommended that artists register their copyrights.²⁶ First of all, if you want to bring a lawsuit in the United States, you will have to register the work beforehand.²⁷ Registration is also recommended because artists will want to have the facts of their copyright on public record to put others on notice, and obtain the certificate of registration as proof.²⁸ In addition, registered works may be eligible for statutory damages as well as attorney’s fees if they are successful at litigation.²⁹ Lastly, a registered work within five years of publication is considered “prima facie evidence in a court of law.”³⁰

Most courts interpret copyright statutes to read that an actor’s performance is not protectable under copyright law,³¹ however some judges disagree with this interpretation.³² A larger work that has many moving pieces, like a film, is usually considered a “joint work consisting of a number of contributions by different authors.”³³ A work is considered a joint work only if all of the authors involved in its creation intend it to be.³⁴ When there are multiple authors, some circuits recognize a “dominant author” doctrine, which is when “one person is indisputably the dominant author of the work and

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*

²⁸ Circular 1, “Copyright Basics.”

²⁹ *Id.* (Statutory damages are capped, however, so actors would prefer royalties or lost profits.).

³⁰ *Id.*

³¹ *Garcia*, 786 F.3d at 741.

³² *Supra* note 43.

³³ 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 6.05 at 6-14 (1990).

³⁴ 17 U.S.C § 101.

the only issue is whether that person is the sole author or she and another are joint author.”³⁵ These Circuit Courts look to the totality of certain factors to determine who is the “dominant author of the work.”³⁶ These factors include “decision-making, authority, billing, and written agreements with third parties”.³⁷

In the Second Circuit case, *Thomson v. Larson*, the plaintiff claimed that she co-authored a “new version” of the world famous Broadway musical *Rent*.³⁸ In this case, the plaintiff and defendant did not “specify their respective rights by contract”, so the court looked to whether the plaintiff was a “co-author” and if she “automatically retain[ed] exclusive copyright interests in the material she contributed to the work.”³⁹ In determining joint authorship, the court looked to the “*Childress Requirements*,” which are the “standards for determining when a contributor to a copyrighted work is entitled to be regarded as a joint author.”⁴⁰ According to these standards, courts are to determine the parties’ intent to be bound through the totality of certain factors, which included decision-making authority, billing, and written agreements with third parties.⁴¹ The court here ruled for the defendant because it held that the plaintiff did not have the defendant’s intent to be bound as joint authors when weighing the totality of these factors.⁴²

An important exception to copyright infringement in larger works is when a contribution falls within the work made for hire doctrine.⁴³ A work made for hire is “a work prepared by an employee within the scope of his or her employment; or a work

³⁵ *16 Casa Duse, LLC v. Merkin*, 147 F.3d 247, 260 (2d Cir. 2015).

³⁶ *Id.*

³⁷ *Thomson v. Larson*, 147 F.3d 195, 202-04 (2d Cir. 1998).

³⁸ *Id.* at 196.

³⁹ *Id.*

⁴⁰ *Childress v Taylor*, 945 F.2d 500, 501 (2d Cir. 1991).

⁴¹ *Thomson*, 147 F.3d at 196-98.

⁴² *Id.* at 207.

⁴³ 17 U.S.C § 101.

specially ordered or commissioned for use as a contribution to a collective work...”⁴⁴ In the film and television industry, contributions to motion pictures and shows fall under subsection 2 of 17 U.S.C § 101.⁴⁵ No written instrument is required in the case of employee work.⁴⁶ However “a written instrument is required in the case of a work prepared on special order or commission to make it a work made for hire.”⁴⁷ This means that the creator of the contribution must consciously give up the copyright to their work through an express contract.⁴⁸ However, the question is who owns the performance when the creator and actor do not contract to do so.

The question of ownership over an actor’s performance within a larger work, like a motion picture, is a new and prevalent debate.⁴⁹ Just because an actor is not a joint author, does not mean they do not have a copyrightable interest in their personal performance within the film.⁵⁰ “Nothing in the Copyright Act suggests that a copyright interest in a creative contribution to a work simply disappears because the contributor doesn’t qualify as a joint author of the entire work.”⁵¹ “An actor’s performance, when fixed, is copyrightable if it evinces ‘some minimal degree of creativity . . . no matter how crude, humble or obvious it might be’”⁵²

b. The Current State of the Issue and How it affects the Circuit Courts

⁴⁴ *Id.*

⁴⁵ SHERRI BURR, ENTERTAINMENT LAW IN A NUTSHELL 186 (West, 3d ed. 2004).

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *See, Garcia v. Google Inc; See Conrad v AM Community Credit Union; see also, 16 Casa Duse, LLC v. Merkin, 791 F.3d 247 (2d Cir. N.Y. 2015).*

⁵⁰ *Garcia*, 743 F.3d at 932-34.

⁵¹ *Id.* (citing 17 U.S.C. § 102(a)).

⁵² *Id.* at 934 (quoting *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co*, 499 U.S. 340, 345 (1991)).

According to the statute's purpose, actor's performances deserve protection from copyright law. However, they still receive little to no protection in the United States. Most federal courts hold that an actor's personal performance is not copyrightable.⁵³ These courts state that "[i]f copyright subsisted separately in each of their contributions to the completed film, the copyright in the film itself, which is recognized by statute as a work of authorship, could be undermined by any number of individual claims"⁵⁴ Many experts believe that this is an incorrect interpretation of the statute.⁵⁵ In addition, there is often dissenting opinion among the Circuit Judges within these decisions, which points to the disagreement over how this statute should be interpreted.⁵⁶

The majority of courts look to three factors when debating whether or not an actor's performance is protectable.⁵⁷ Those things are whether it is an original work according to the statute's definition, does the party have authorship over the work, and is it fixed in a tangible medium.⁵⁸ In *Garcia v. Google, Inc.*, an actress was "bamboozled" when a movie producer transformed her five-second acting performance into part of a blasphemous video proclaiming against the Prophet Mohammed.⁵⁹ The actor was unable to protect herself from physical threat when the Copyright Office found that the plaintiff's performance was not a copyrightable work and rejected her copyright application.⁶⁰ "The Copyright Office explained that its 'longstanding practices do not

⁵³ See, *Garcia v. Google Inc.*; See *Conrad v AM Community Credit Union*; see also *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247 (2d Cir. 2015).

⁵⁴ *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247 (2d Cir. 2015).

⁵⁵ Gardner, Eriq, "Actors Guild Gets Behind Copyrights for Some Performers", *Hollywood Reporter*, (Dec. 8, 2014), <http://www.hollywoodreporter.com/thr-esq/actors-guild-gets-behind-copyrights-754973>.

⁵⁶ *Supra* note 2.

⁵⁷ *Garcia*, 786 F.3d at 741

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

allow a copyright claim by an individual actor or actress in his or her performance contained within a motion picture.’”⁶¹

Today it is clear that this area of the arts deserves protection. However, a court could not extend the statute to do so with the way the statute is currently written. If it did, so many smaller contributors of a larger work could make copyright claims. Judge McKeown, who delivered the majority’s opinion in the revised en banc decision in *Garcia v. Google, Inc.*, states that the plaintiff’s “theory can be likened to ‘copyright cherry picking,’ which would enable any contributor from a costume designer down to an extra or best boy to claim copyright in random bits and pieces of a unitary motion picture without satisfying the requirements of the Copyright Act.” It is obvious that Congress should avoid a slippery slope of a possible in flux of copyright claims by small players within larger works. However, is it not clear that acting is an art that deserves protecting? Aren’t actors key players in these large works and comparable in importance to the art of filmmaking as directors and screenplay writers? Don’t actors often improvise scenes and perform their parts based on personal interpretations?

Garcia showed how difficult it is to interpret this statute in regards to an actor’s rights.⁶² Even though the actor’s role was minimal here, the court first ruled incorrectly that her performance was protectable under copyright law.⁶³ These inconsistencies like in this opinion alone show a need for clarification by Congress or an amendment to the statute. The en banc review in *Garcia* ultimately got the decision correct, but the opinion shows that Judge McKeown was still somewhat skeptical of whether or not an actor

⁶¹ *Id.*

⁶² *Garcia*, 743 F.3d at 932-33.

⁶³ *Id.*

deserved protection. He states that “[b]ecause our review is deferential, ‘we will not reverse the district court where it ‘got the law right,’ even if we ‘would have arrived at a different result,’ so long as the district court did not clearly err in its factual determinations.”⁶⁴ The Ninth Circuit, which is the most progressive when it comes to copyright protection, seems to be hinting that they would have come to a different result than the lower court had it heard the case first, but felt that the lower court still did not err in its judgment so it would be improper to reverse as it previously did. How can two courts from the same region interpret a law so differently? This is most likely because the courts recognize that actors are artists who make major contributions to joint works like film, but Congress has yet to recognize them within federal copyright law.

In the case *16 Casa Duse, LLC v. Merkin*, the Second Circuit decided whether or not a contributor of a creative work owns the copyright over their work when the contribution is inseparable from and integrated into the overall work.⁶⁵ The plaintiff was the director of the overall work, which was owned by the defendant who hired the plaintiff as director.⁶⁶ The defendant had sent the plaintiff a Director Employment Agreement during the hiring process, which stated that the defendant owned the film, however it was never signed or executed by the plaintiff.⁶⁷ After numerous attempts by the defendant to have the plaintiff sign the agreement, time became an issue and the plaintiff began working without executing the agreement.⁶⁸ The plaintiff then registered a copyright over the film, and the defendant later began submitting the film-to-film

⁶⁴ *Garcia*, 786 F.3d at 739-40.

⁶⁵ *Merkin*, 791 F.3d at 250-52.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.*

festivals in plans to publicize it.⁶⁹ The plaintiff then threatened the film festivals with a cease and desist order, which led to the suit of who owned the copyright.⁷⁰ The Second Circuit ruled for the Defendant holding that “while originality and fixation are necessary prerequisites to obtaining copyright protection...they are not alone sufficient: Authors are not entitled to copyright protection except for the ‘works of authorship’ they create and fix.”⁷¹

Clearly in this case, the director had made huge contributions to the work, but even then the law saw this as not enough to have any ownership, regardless of an executed agreement. An actor creates his performance in the way he interprets the role. The Copyright Act explicitly states that it does not protect ideas, but only works fixed in a tangible medium, which demonstrates originality and creativity. The actor’s performance does all of these things, yet receives no protection when most other major contributors to art does.

III. The Circuit Split

In 2014, the Seventh Circuit heard *Conrad v. AM Community Credit Union*, where an actor filed suit over violation of her copyright in a character she created during a performance at a trade association event.⁷² The plaintiff was a “self-employed singing

⁶⁹ *Id.*

⁷⁰ *Merkin*, 791 F.3d. at 253.

⁷¹ *Merkin*, 791 F.3d 247 (citing *Garcia*, 786 F.3d at 739-40).

⁷² *Conrad v. AM Cmty. Credit Union*, 750 F.3d 634, 635-36 (7th Cir. 2014).

and dancing entertainer (also a writer and motivational speaker)” who calls herself the “Banana Lady.”⁷³ The “Banana Lady” was hired to perform a “singing telegram” at a credit union trade association event.⁷⁴ The plaintiff had a valid copyright over her character and asked audience members not to photograph or videotape the performance for any purposes other than personal use.⁷⁵ However audience members still recorded the performance, and then posted clips and pictures from the performance to their social media pages and the Internet regardless of the plaintiff’s request.⁷⁶ The Seventh Circuit held that the “performance itself was not copyrighted or even copyrightable” and found no violation of copyright because the performance itself could not be copyrightable since it was not “fixed in any tangible medium of expression.”⁷⁷

The Ninth Circuit, one of the most progressive courts in regards to copyright law, has also heard claims in regards to actor protection.⁷⁸ In the case *Garcia v. Google, Inc.*, an actress was casted to perform a short scene for the film “Desert Warrior”, which took place in Arabia.⁷⁹ The plaintiff was paid “approximately \$500 for three and a half days of filming”, and she expected the scene to be used only for this film.⁸⁰ However, the director instead used the actress’ performance in an anti-Islamic film that he later posted online.⁸¹ The plaintiff’s scene had been “partially dubbed over” and the director made it seem like she was asking, “[i]s your Mohammed a child molester?” in the film.⁸² This is

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014).

⁷⁹ *Id.* at 1261-62.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.*

a very dangerous public blasphemy against the extremely faithful Muslim population.⁸³

The plaintiff soon began receiving threats against her life and had to take a number of safety precautions after the film aired.⁸⁴

Garcia v. Google still continues to receive criticism to this day for how the courts handled this sensitive issue.⁸⁵ In this complex case, the Ninth Circuit originally ruled that the plaintiff would likely succeed on the merits because the filmmaker used the actor's "performance in a way that exceeds the bounds of the broad implied license granted" to the actor of the screenplay.⁸⁶ However the case had a very complex aftermath and ultimately was reviewed en banc and reversed.⁸⁷

The Court stated that an implied license can arise "where the plaintiff's contribution to a film or other work would otherwise be worthless or of 'minimal value.'"⁸⁸ The small role the plaintiff played here would have fell within this category had the performance been released as a part of the original screenplay.⁸⁹ The performance was used, however, in a different movie that the actor did not know she would be apart of.⁹⁰ The Ninth Circuit held that there was no implied license here because the creator of the film had lied to the actress as to what the performance would be used for, and this lie resulted in irreparable harm to the actor.⁹¹ The Court decided

⁸³ *Id.*

⁸⁴ *Garcia v. Google, Inc.*, 743 F.3d 1258, 1261-62 (9th Cir. 2014)

⁸⁵ Gardner, Eriq, Controversial 'Innocence of Muslims' Ruling Reversed By Appeals Court, HOLLYWOOD REPORTER, (May 18, 2015), <http://www.hollywoodreporter.com/thr-esq/controversial-innocence-muslims-ruling-reversed-796530>.

⁸⁶ *Id.* at 938.

⁸⁷ *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. Cal. 2015),

⁸⁸ *Id.* at 737 (quoting *Effects Assocs. v. Cohen*, 908 F.2d 555, 558-59 (9th Cir. 1990).

⁸⁹ *Id.* at 737.

⁹⁰ *Id.* at 732-33.

⁹¹ *Garcia*, 743 F.3d. at 1261-62.

that the plaintiff had ownership over her copyrightable performance and would likely succeed on the merits, so she was granted an injunction.⁹²

The Ninth Circuit later voted to rehear the case en banc.⁹³ The Court vacated its prior opinion and affirmed the lower court's decision in May 2015.⁹⁴ In this controversial second decision, the Ninth Circuit stated that the plaintiff "was not likely to prove her performance was a 'work' nor would she likely meet the copyright requirements of authorship and fixation".⁹⁵ The Ninth Circuit also stated that the original decision did not implicate the First Amendment, which is important in this expression of free speech in a politically significant film.⁹⁶ The Court held that awarding an injunction for the short clip that the actress was apart of would also violate First Amendment rights of the film's creator as well.⁹⁷ The Ninth Circuit did not feel that the lower court abused its discretion and could not reverse the decision, regardless of the potential harm to the actress' well being or to her performance.⁹⁸

The en banc revised decision was a split one with Judge Kozinski dissenting.⁹⁹ Judge Kozinski said that the plaintiff's dramatic performance "met all of the requirements for copyright protection: It was copyrightable subject matter, it was original, and it was fixed at the moment it was recorded."¹⁰⁰ Based on this first quote of the dissent, it is apparent that the statute is unclear when it comes to copyright protection of an actor's performance. Judge Kozinski went on to say how "daunting" it is to think that a

⁹² *Id.* at 1268-69.

⁹³ *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015).

⁹⁴ *Id.*

⁹⁵ *Id.* at 739

⁹⁶ *Id.*

⁹⁷ *Id.* at 747.

⁹⁸ *Garcia*, 786 F.3d at 748-49.

⁹⁹ *Id.* at 749 (Kozinski, A., dissenting).

¹⁰⁰ *Id.*

performance like the plaintiff's cannot be considered a work under copyright protection.¹⁰¹ "If [the plaintiff's] scene is not a work, then every take of every scene of, say, *Lord of the Rings* is not a work, and thus not protected by copyright, unless and until the clips become part of the final movie."¹⁰²

The first and later revised decision by the Ninth Circuit in *Garcia v. Google, Inc.* received much criticism.¹⁰³ Legal experts and attorneys have felt the Ninth Circuit had misinterpreted the Copyright Act in this decision.¹⁰⁴ Clearly there is an issue in regards to the interpretation of the Copyright Act in regards to an actor's individual performance. A disagreement of this magnitude shows how difficult it is to interpret this copyright statute in regards to an actor's performance. Also it is important to point out that the scene was less than a minute, but even such a short scene created confusion in the courts.¹⁰⁵ What would have been the result had the scene been a substantial part of the film?

It is uncertain who owns the rights to an actor's performance as shown in the decisions within our federal circuit courts. An actor's performance is an individual's original work and their interpretation of the role should be viewed as authorship and creativity by our federal laws. An actor's performance is fixed within the tangible mediums defined within the federal statute, so the Copyright Act should therefore offer some sort of protection. The decisions in the Seventh and Ninth Circuits show a clear need for a provision within the Copyright Act that defines when an actor's performance

¹⁰¹ *Id.* at 750 (Kozinski, A., dissenting).

¹⁰² *Id.*

¹⁰³ Mentzer, Stefan. THE GARCIA V. GOOGLE CONTROVERSY AND WHAT IT MEANS FOR CONTENT OWNERS AND USERS, <http://www.lexology.com/library/detail.aspx?g=3b6ff140-49a1-4a85-9f90-b27d5987937a>, (Lexology, 2014).

¹⁰⁴ *Id.*

¹⁰⁵ *Garcia*, 743 F.3d at 737.

should be protected. If federal circuit court judges cannot agree as to an interpretation of the statute,¹⁰⁶ then how can actors and performers know when they have a legal claim for protection?

IV. Where do we go from here?

a. Proposed Solution

The Copyright Act needs to be amended once more to clarify certain provisions and carve out a new category for performances. It is key that our laws to keep up with changing times and the development of our philosophies and technology. The Copyright Act has been amended numerous times over its history.¹⁰⁷ This is another point in the development in this area of law. When new areas are seen to be evolving as major contributors in the field of art, the law must recognize it. Like how the Act was amended 200 years ago when it recognized music as art, the same must happen today in regards to individual's performances in acting.

The way the Copyright Act currently reads does make it hard to argue with the Circuit Courts' decisions in *Garcia*, *Merkin*, *Conrad*, and other similar federal decisions. However, it is also clear in these opinions that actors deserve protection as much as the other contributors to joint works. At least the statute itself should be clarified in regards to the art of acting, which is a clearly recognizable and practiced art form.

Allowing actors copyright protection under the current statute would be a slippery slope. If federal courts interpreted the statute to include actor's performance, then other

¹⁰⁶ *Garcia*, 786 F.3d at 749.

¹⁰⁷ *Supra* note 31.

small contributors could make claims like Judge McKeown had stated.¹⁰⁸ Though, I think very few people would say actors are not artists whose performances are individual and original works. In addition, the statute could be simply be clarified to read like it does in Canadian copyright law.¹⁰⁹ There, actors are protected, yet there isn't a major influx of litigation within this field.¹¹⁰ There are two possible reasons for this.¹¹¹

First of all, most problems can be addressed by simple contracts.¹¹² As stated above, actors performances can be seen the same way the rest of the film crew's contributions are viewed as work made for hire.¹¹³ Producers, directors, or other types of "owners" of the film can contract with actors and contributors of the film to sign some sort of release or transfer of rights.¹¹⁴ Simply rewording the statute like in Canada, may solve this issue altogether. By explicitly stating that actors can get protection in certain situations, like in Canada, will force the owners of film to take steps to mitigate this risk. Most studio heads with their experienced legal counsel will contract with their performers to release these types of rights regardless to avoid any type of lawsuit. However, in today's world, films are made more often than ever on an independent basis with the technological ability and freedom of all to reach consumers globally using the Internet.¹¹⁵ Films often get instant success without the backing of a studio or major funding over the

¹⁰⁸ *Garcia*, 786 F.3d 737.

¹⁰⁹ Tarantino, Bob, "I Didn't Say That – The Ability of Actors to Control Their Performances Under Canadian Copyright Law", Entertainment and Media Law Signal, (May 19, 2015), <http://www.entertainmentmedialawsignal.com/i-didnt-say-that-the-ability-of-actors-to-control-their-performances-under-canadian-copyright-law>.

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ 17 U.S.C § 101.

¹¹⁴ Tarantino, *supra* note 109.

¹¹⁵ FILM CONNECTION, How the Internet Has Changed the Movie Business, <http://www.filmconnection.com/reference-library/film-entrepreneurs/how-the-internet-has-changed-the-movie-biz>.

Internet because of the cheap ability to reach consumers globally.¹¹⁶ Actors and performers in low budget independent films are normally not being paid large amounts of money, giving them more reason to push litigation when one of these independent films takes off. Putting directors and writers on notice with codified law will force those in power to make decisions to mitigate lawsuits, and avoid the possible confusion seen in our circuit courts today.

A second reason for Canada's successful copyright statute with actors and contributors of larger works is the "fail-safe" written into the statute.¹¹⁷ The Canadian Copyright Act states, "when a performer authorizes the embodiment of [his or her] performer's performance in a cinematographic work, the performer may no longer exercise . . . the copyright [in that performance]."¹¹⁸ Therefore, if a performer gives the owner authorization to use their performance in the larger work, then they sacrifice the right to control it.¹¹⁹ "Thus, if there's no need for the performer to memorialize their authorization in a written instrument, it becomes much easier to conclude that a performer authorized the embodiment of their performance simply by agreeing to be present in front of camera."¹²⁰

Copying the Canadian Copyright Act is not necessary, but it does show that providing copyright protection to actors can be done successfully without a tsunami of litigation. The amendment to the American law is necessary just for clarification and a

¹¹⁶ *Id.*

¹¹⁷ Tarantino, Bob, "I Didn't Say That – The Ability of Actors to Control Their Performances Under Canadian Copyright Law", Entertainment and Media Law Signal, (May 19, 2015), <http://www.entertainmentmedialawsignal.com/i-didnt-say-that-the-ability-of-actors-to-control-their-performances-under-canadian-copyright-law>.

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.*

more predictable system. Many actors are barely making it by and are not apart of the one percenters, like Leonardo DiCaprio, who are paid in the multi millions. There is a need to protect their work and opportunity to make a living without the fear of being exploited by the owners of the overall work, like in *Garcia*.

Today, actors have become major contributors and even arguably “authors” of the films they are in.¹²¹ In contemporary filmmaking, the actor is often the sole creator of a scene that transcends the movie.¹²² Actors who are immersed in their role will often go off-script and will naturally create their own dialogue and scenes through their own creative genius.¹²³ For example, Robert DiNiro in “Taxi Driver” delivered one of the most memorable scenes in movie history when he said in front of the camera, “You talkin to me?”¹²⁴ This scene was not apart of the creator’s script.¹²⁵ According to the script, the character Travis was simply supposed to talk to himself in front of the mirror.¹²⁶ DiNero transcended the movie with this brilliant performance. The scene actually gave DiNero free reign to say whatever he thought would work showing that he is a joint author of the script, which is a common occurrence in film and television.¹²⁷ Many times “improv” like this results in its own creative work within a larger work that is more memorable

¹²¹ DIGITAL ACADEMY: THE FILM SCHOOL, Role of Actor in Film Making, (Dec. 9, 2011), <https://dafilmschool.wordpress.com/2011/12/09/role-of-an-actor-in-film-making>.

¹²² A BRIEF INTRODUCTION AND HISTORY, 20 Legendary Movie Scenes that were Improvised out of Surprise, (2015), <http://www.emlii.com/748c8dd3/20-Legendary-Movie-Scenes-That-Were-Improvised-Out-of-Surprise>.

¹²³ *Id.*

¹²⁴ HILTON, PEREZ, 18 CLASSIC MOVIE LINES & SCENES THAT WERE TOTALLY UNSCRIPTED! (Sep. 9, 2014), <http://perezhilton.com/2014-09-15-18-classic-movie-lines-scenes-that-were-totally-unscripited/?from=post#.Vs83M8cSBg0>.

¹²⁵ *Id.*

¹²⁶ *Id.*

¹²⁷ *Id.*

than the movie itself.¹²⁸ However, the brilliant actors who spontaneously create this artwork could never profit off of it based on the current interpretation of the statutes.

In the most memorable scene from the infamous movie *The Shining*, for example, Jack Nicholson pokes his head through a hole in the door and yells, “Here’s Johnny!” This scene and its dialogue is arguably more well-known than the plot of the movie itself, however, Nicholson could never copyright or patent this line as it is apart of a bigger work owned by the movies’ copyright owner (likely the production company or writer who had nothing to do with it).¹²⁹ This shift in how important the actor is towards the overall success of a film, shows a need for protection. In addition, many more films are being created independently with advances in technology, which add to this need.

Actors are major contributors to the arts and their performances are often based on spontaneity and personal interpretation of the part.¹³⁰ If the director or author of the screenplay is the exclusive owner of the work, then “every schmuck...is an actor because everyone...knows how to read.”¹³¹ An actor does far more than speak the words on a page; “he must live his part inwardly, and then ... give to his experience an external embodiment.”¹³² That embodiment includes body language, facial expression and reactions to other actors and elements of a scene.¹³³ This embodiment of the character and response to the other actors in the scene is something that cannot be written down by another.

¹²⁸ *Supra* note 122.

¹²⁹ 17 U.S.C.

¹³⁰ Caine, Michael. *Acting in Film: An Actor’s Take on Movie Making*. Applause Acting Series. Edited by Maria Aitken. P 68-73

¹³¹ *Garcia at 934* quoting Sanford Meisner & Dennis Longwell, *Sanford Meisner on Acting* 178 (1978).

¹³² Constantin Stanislavski, *An Actor Prepares* 15, 219 (Elizabeth Reynolds Hapgoods trans., 1936).

¹³³ *Id.*

This performance is something truly original and creative, which deserves to be protected and owned by the actor. Copyright law's main goal is to further the Arts and Sciences through awarding those who display originality and creativity.¹³⁴ If only those who create the script or direct the scenes have control over the award, how would the art of acting be furthered? An actor would be less willing to tap into their own ingenuity in a role because whatever work they created would belong to the author of the scene itself. That would not be a just system.

To remedy this, an amendment is needed to cover an actor's performance. The amendment however cannot be too broad as to protect all actors and should prevent a large number of copyright claims from minor contributors in joint works. The amendment to the United States Copyright Act should be a provision that covers joint works specifically, since this is where the main source of confusion lies.¹³⁵ The Canadian Copyright Act is a good starting point for our own amendments. It is clear their laws have been successful with much less criticism.

Another portion of the Canadian Copyright Act that could be considered in our own amendments, would be their protection over "moral rights."¹³⁶ The concept of moral rights originated in France, where it recognizes six moral rights worth of legal protection.¹³⁷ They are the right to create, right of disclosure, right to withdraw work after it has been disclosed, right of authorship, right of integrity, and right of protection

¹³⁴ 17 U.S.C. § 102

¹³⁵ *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231-36 (9th Cir. 2000).

¹³⁶ Tarantino, Bob, "I Didn't Say That – The Ability of Actors to Control Their Performances Under Canadian Copyright Law", Entertainment and Media Law Signal, (May 19, 2015), <http://www.entertainmentmedialawsignal.com/i-didnt-say-that-the-ability-of-actors-to-control-their-performances-under-canadian-copyright-law>.

¹³⁷ Burr, *supra* note 45, at 192-94.

from excessive criticism.¹³⁸ The United States, however, only “recognizes the Right of Authorship and the Right of Integrity in 17 U.S.C. § 106A, but has considered other areas of moral rights as well.¹³⁹

In *Garcia*, it was clear that there were moral issues with the fraudulent use of one’s performance in a way that they did not agree to, regardless of who owns the script.¹⁴⁰ In the later en banc reversing decision, the Ninth Circuit stated that it is clear the plaintiff has experienced injustice and should pursue other civil claims within other fields since copyright did not cover this harm.¹⁴¹ The Ninth Circuit recognized how incredibly unfair this actress was treated here, yet the court felt it could do nothing to fix it. It almost seems unjust that even though an actor can be defrauded in such a malicious way, yet have to claims in copyright law.

The Canadian Copyright Modernization Act, which was an amendment of their copyright law enacted in 2012, extends moral rights to some performances.¹⁴² Moral rights cannot be assigned, but they can be waived and there is no requirement that the waiver be in writing according to Canadian law.¹⁴³ This protection is provided when moral rights are “infringed on” in an artist’s performance.¹⁴⁴ In *Garcia*, the Court even pointed out that the plaintiff is not even “protected by the benefits found in many European countries, where authors have “moral rights” to control the integrity of their

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. Cal. 2015).

¹⁴¹ *Id.*

¹⁴² Tarantino, Bob, “I Didn’t Say That – The Ability of Actors to Control Their Performances Under Canadian Copyright Law”, Entertainment and Media Law Signal, (May 19, 2015), <http://www.entertainmentmedialawsignal.com/i-didnt-say-that-the-ability-of-actors-to-control-their-performances-under-canadian-copyright-law>.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

works and to guard against distortion, manipulation, or misappropriation.”¹⁴⁵ The court recognized that other nations provide moral protection whereas ours does not. The United States is the clear leader in film, television, and entertainment, yet our laws seem to be way behind those of other smaller national contributors in this industry. There is a clear need for our laws to be updated to keep up with our peers.

When a film has many joint authors, all should be protected since they are furthering the arts and sciences with their original work. There is no reason a court could not split up profits or protection, the same way it does in other fields of law. The provision should only protect major contributors to a joint work. A list of factors within the statute would clarify whether an artist has sufficiently contributed to be protected. Those factors could include substantiality of the contribution, time committed to the work, originality and creativity of the contribution, and artistic value added to the work. Other factors that should be considered as well include wages, official title, advertising and production costs, amount of time on screen, and awards received. Joint authorship would be a question of fact determined on a case by case basis since no two films or television shows are the same when it comes to cost, contribution, or success. A jury would determine who deserves this credit based on the totality of circumstances among these factors.

In the amendments, it would clearly specify the steps needed to determine if they are a joint author and provide a right to the profits for those joint authors. It seems too black and white to say that only one owner of the film has a copyright in it. Parts of films can be divided up amongst its contributors, so that all have a share of the profits. The

¹⁴⁵ *Garcia*, 786 F.3d at 746 (citing *Kelley v. Chicago Park Dist.*, 635 F.3d 290, 296 (7th Cir. 2011)).

focus should be on the amount a joint author contributed and the artistic value of it. All actors should not be protected since many performances are simply the result of a director or screenplay's description of a role. If the individual's performance is necessary to the overall work, or the replacement of the individual would result in destruction of the overall piece, they should be protected.

b. Why it is better

It is clear that actors are artists who provide original and creative twists to the roles that they are to play. It is also clear that many times these actors are major contributors to the films they are casted in. This alone shows a need to protect this group of artists the same way that the director's and screenplay writer's works are protected. It is not up to the federal law to determine whose art is more important and should therefore be protected. The way the current system operates in film shorts a major contributor of the artistic value of the work. It only protects those who are directors and writers, even though an actor may have implied power over the work since they are the focal point.

There is question as to the incentive theory of copyright law here since major actors are compensated quite well in our country. Also, most actors are under contract with the owners of the film as well as with the Screen Actor's Guild union, so there is argument that there is no need to protect actors. In addition, many actors earn very healthy livings, so there is little need for protection since they are not concerned with extended profits from their performances. However, the majority of actors across filmmaking are not apart of this group and only a small percentage of actors are making

that type of income.¹⁴⁶ More than half of all actors are under the poverty line, and many don't even make minimum wage when they are working.¹⁴⁷ Not to mention with our advancement in technology, specifically the Internet and Web2.0, there has been an influx of issues copyright law has had to deal with.¹⁴⁸

In addition with the way the law is currently written and with the advancements of technology, those whose copyrights are infringed on or who are unfairly defrauded in the field of film have very few successful solutions as is. When independent or small film makers defraud their performers or infringe on others copyrights, the victim will then likely seek an injunction against them in court. However, is an injunction even a very useful remedy in today's entertainment world? Once the work hits the "web", there is no telling where it will go and who will benefit from it.¹⁴⁹ An injunction may stop the original wrongdoer, but it's nearly impossible to stop the other negative effects in today's cyber world.¹⁵⁰ Even though each person who shares and contributes to the spreading of a protected work is in contempt of court, its almost impossible for authorities to begin "with hunting" all of them.¹⁵¹ Social media alone provides opportunity for people to share information that may have been awarded an injunction and is protected in court, to break the law and benefit from the information through the click of a button.¹⁵² The law

¹⁴⁶ Rush, Morgan. "What are the Chances of Making it as an Actress", <http://work.chron.com/chances-making-actress-27205.html>, (Demand Media 2015).

¹⁴⁷ Vincent, Alice. "More than half of actors are under poverty line", The Telegraph (Jan. 17, 2014), <http://www.telegraph.co.uk/culture/theatre/theatre-news/10574735/More-than-half-of-actors-are-under-poverty-line.html>.

¹⁴⁸ Kasunic, Robert, "Copyrights Uneasy Transition Into The Web 2.0 Environment", American Bar Association (Landslide 2009).

¹⁴⁹ Barnett, Emma. "Twitter shows the internet cannot be bound by super-injunctions", The Telegraph (May 9, 2011), <http://www.telegraph.co.uk/technology/twitter/8502539/Twitter-shows-the-internet-cannot-be-bound-by-super-injunctions.html>.

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

is struggling to keep up with the times, and provides little relief in the world of entertainment with how it is currently written and executed.

Many actors now are not members of unions or have contracts with their filmmakers since so many individuals create artistic works that are easily accessible by the entire nation immediately.¹⁵³ It is very difficult to predict which works will have artistic impact or which will have financial reward possibility. Who would have copyright protection when an independent filmmaker creates an original work and posts it to the Internet with an actor playing a major role in the piece? If the work receives mass popular attention and there is a possibility for financial reward, who gets to reap the benefits of the copyright protection? This change in technology and the ability for small independent groups to get global attention for their artistic work so quickly creates a need for an amended statute.

c. Practical ramifications of implementing solution

Once the Copyright Act is amended to include a provision on joint works, specifically for actors, the likely effect in major motion picture production would be increased contracts between the filmmakers and their cast to create a licensor-licensee relationship between the two. As seen in the Canadian legal system, the creation of protection for actors does not result in an influx of litigation.¹⁵⁴ Directors, writers, and creators of large collaborative works like film will be more likely to contract with every

¹⁵³ Vincent, Alice. "More than half of actors are under poverty line", The Telegraph (Jan. 17, 2014), <http://www.telegraph.co.uk/culture/theatre/theatre-news/10574735/More-than-half-of-actors-are-under-poverty-line.html>.

¹⁵⁴ *Supra* note 95.

contributor of the film. Clarifying explicitly in law and putting people on notice alone will serve as a solution to any possible uncertainties over this split.

In the independent and Internet user generated film industry, the likely effect would be claims by actors for copyright protection when there is infringement or financial gain. However, even here, experienced directors or anyone with the Internet can have knowledge of these laws protecting contributors. In Canada, even in an age of such technological advancement in entertainment, there is little litigation in this field showing that an amendment could serve as a very successful solution.¹⁵⁵ Not to mention in regards to moral dilemmas like those seen in *Garcia*, which were most likely one of the main reasons the circuit handled the dispute so poorly.¹⁵⁶ It was clear that there was a need for justice to step in, yet there was no way the Court could help the plaintiff the way the statute currently reads.¹⁵⁷ Adding a moral rights extension to the law like seen in European and Canadian systems would avoid such potential injustices. In either case, whether there is a moral injustice taking place or simply someone's right to revenues are being taken advantage of, there is a need for change. If there is a hole in a law, or if a statute can be misinterpreted, clever crooks will always find such gray areas and take advantage for their own personal gains. When this happens, the law needs to change or adapt to counter such unfairness.

V. Conclusion

¹⁵⁵ *Id.*

¹⁵⁶ *Supra* note 123.

¹⁵⁷ *Id.*

In conclusion, there is a great need for clarification over joint works within United States copyright law, especially in the film making industry. In particular, the Copyright Act needs to be amended to provide protection to actors who play a major role in the creation of an original piece. Copyright law in other jurisdictions, such as Canada, have been more successful in protecting contributors to major pieces, like film, while at the same time avoiding unnecessary and costly litigation.¹⁵⁸

The purpose of copyright law in the United States is to further the arts and sciences as it is expressed in the Constitution. If the authors are the only people with exclusive rights over a joint work, like a film, then they would have complete control over any creative changes the directors, actors, or other moving pieces make. Fraudulent owners of a joint work have full control over any artistic expression by the actors working with a loosely based script, regardless of what the performers had intended. Any changes made during the film's creation by these joint authors would be owned by individuals who had little to do with their originality or creativity.

Preventing creative geniuses from protection over their work would only hinder the overall purpose Congress had when creating copyright laws. When actors create an original performance, they deserve legal protection of their work to further progress the Arts. An actor would otherwise have no reason to put his or her originality into a role since the rights or any value of it belongs to someone else. Currently the way the statute is unclearly written creates room for inconsistent results and the ability for non-creators to take claim for other people's work. The United States should amend their copyright laws to create clarity and give protection to artistic performers. At the very least this will

¹⁵⁸ *Supra* note 95.

force directors and screenplay writers to contract with their performers to release their rights to the performance. The industry is constantly changing especially with the introduction of Web 2.0, and there is a need to stay ahead of these issues instead of responding retroactively. Actors are not protected as artists the way the law is currently written, and these issues will continue to persist as independent directors and artists gain success through advancements in technology. If the statutes aren't amended, actors will continue to be taken advantage of and seen as nothing more than puppets reading a script.